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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,835

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EXAMINER

GERIDO, DWAN A

ART UNIT

PAPER NUMBER

1797

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,835	<b>Applicant(s)</b> TELIMAA ET AL.	
	<b>Examiner</b> Dwan A. Gerido, Ph.D.	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, applicant recites angles  $\phi_{1-3}$  without stating parameters for the claimed angles. For the purposes of examination, angles  $\phi_{1-3}$  will be regarded as any angles between 0-360°. In addition, it is unclear as to what applicant regards as the display part as applicant does not specify any structure to differentiate the display part from other components of the claimed pipette.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-5, and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scordato et al., (US 20020012613) in view of Oshikubo (US 4,909,991).

7. With regards to claims 2-5, Scordato et al., teach an electric pipette wherein the hook portion is rotatable about the shaft of the pipette which is being read as meaning 360°. Scordato et al., do not teach a pipette wherein the rotatable parts comprise a hook portion and a push button.

Oshikubo teaches a pipette comprising a push button part that is rotatable about the vertical axis of the pipette. It is well known in the art that push buttons are utilized as a second means of adjusting the volume in a handheld pipette. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Scordato et al., in view of Oshikubo in order to provide a second means of changing volume on a pipette.

8. With regards to claims 2-5, Scordato et al., in view of Oshikubo teach the hook and push button parts rotatable between 0-360°. Because the hook and push button parts are rotatable over 360°, the device as taught by Scordato et al., in view of Oshikubo would be fully capable of rotating over the ranges of -90-90°, -70-70°, and -50-50°.

Art Unit: 1797

9. With regards to claims 9-13, Scordato et al., teach an electric pipette wherein a hook portion is rotatable about the vertical axis (paragraph 0037). ). Scordato et al., do not explicitly teach the hook portion being rotatable over a range of 0-360°. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Scordato et al., in a manner in which the hook portion rotates from 0-360° in order to allow the user to adjust the hook portion for maximal comfort to the user as taught by Scordato et al. Also, Scordato et al., explicitly recite the hook being rotatable "about" the shaft which is being read as meaning 360°. Because the hook is being read as rotatable over 360°, the device as taught by Scordato et al., would be fully capable of rotating over the ranges of -90-90°, -70-70°, and -50-50°.

Scordato et al., do not teach a push button and display part rotatable about the vertical axis. Oshikubo teaches a pipette wherein the push button and display parts are rotatable 360° about the vertical axis (column 7 lines 4-10, column 9 lines 12-15, 39-42). The push button and display of Oshikubo rotates 360°; therefore, it would be fully capable of rotating through angles  $\phi_{1-3}$ . Because the display and push button of Oshikubo rotates 360°, it would be fully capable of rotating over ranges of 0-60°, 0-50°, and 0-40°. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Scordato et al., in view of Oshikubo to gain the advantage of providing an adjustable display in order to allow easy viewing of the display by the from any orientation when using the pipette.

10. Claims 6-8, and 14-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Scordato et al., (US 2002/0012613) in view of Oshikubo (US 4,909,991) as applied to claim 10 above, and further in view of Jarvimaki et al., (US 4,988,481).

Art Unit: 1797

11. With regards to claims 6-8, Scordato et al., in view of Oshikubo do not teach a pipette wherein the display part is rotatable about a horizontal axis of the pipette body.

12. Jarvimaki et al., teach an electric pipette comprising a rotatable joint (column 2 lines 14-17) that rotates the pipette and display part (column 2 lines 64-68) along a horizontal axis of the handle. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Scordato et al., in view of Oshikubo to gain the advantage of providing an adjustable display in order to allow easy viewing of the display by the user from any orientation when using the pipette.

13. With regards to claims 14-16, Scordato et al., in view of Oshikubo do not teach a pipette wherein the display part is rotatable about a horizontal axis 0-60, 0-50, or 0-40 degrees.

Jarvimaki et al., teach an electric pipette comprising a rotatable joint (column 2 lines 14-17) that rotates the pipette and display part (column 2 lines 64-68) along a horizontal axis of the handle. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Scordato et al., in view of Oshikubo to gain the advantage of providing an adjustable display in order to allow easy viewing of the display by the user from any orientation when using the pipette.

### ***Response to Arguments***

14. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection. Applicant has amended independent claim 1 to include two rotatable parts wherein the angles of rotation are designated  $\phi_{1-3}$ . The limitations of claim 1 are met by Scardato et al., in view of Oshikubo wherein the combination of references teach a pipette with two rotatable parts as recited by the instant claims.

Applicant has also amended the claims to include a display part that is rotatable about a horizontal axis of the pipette. As stated above, the limitations regarding the display part are unclear as applicant does not provide any structural features to differentiate the display part from the rest of the pipette. When read in light of the rejection under 35 U.S.C 112, the claimed limitations are obvious over Scardato et al., in view of Oshikubo, in further view of Jarvimaki et al as explained above.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwan A. Gerido, Ph.D. whose telephone number is (571)270-3714. The examiner can normally be reached on Monday - Friday, 9:00 - 6:30.

Art Unit: 1797

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lyle A Alexander/  
Primary Examiner, Art Unit 1797

DAG